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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,651	06/26/2001	Hans-Heinrich Muller	31512-172587	9122

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[REDACTED] EXAMINER

WALLS, DIONNE A

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/888,651	MULLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dionne A. Walls	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 March 2003.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 6-14 and 16-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 16 is/are allowed.

6) Claim(s) 6-11, 13, 14, 17 and 18 is/are rejected.

7) Claim(s) 12 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### ***Response to Amendment***

The amendment filed on October 3<sup>rd</sup>, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "a steel paneling which is coated with tungsten carbide/cobalt".

The Examiner notes that Applicant has asserted that the language added to the specification corrects a translation error from the priority document which, as stated on the first page of the specification, is incorporated into the written specification by reference. The Examiner also notes that on March 26<sup>th</sup>, 2003, Applicant submitted a Certificate / Declaration from a translator certifying the accuracy of the corrected translation as it relates to the "tungsten carbide" being changed to "tungsten carbide-cobalt". However, there is no statement verifying the change regarding "a steel paneling" which is coated with the cermet – which replaced the phrase "linings of tungsten carbide". Again, unless Applicant provides a certified copy of the English translation of said document verifying the content of the priority document (and, hence, the amended language), the Examiner will assume the added language is new matter, and request that Applicant cancel such language in the reply to this Office Action.

***Claim Objections***

Claims 8-14 are objected to because they depend from a cancelled base claim.

For examination purposes, the Examiner assumes that these claims are intended to depend from Claim 17. Correction is requested.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 9-10, and 17-18 are rejected under 35 U.S.C. 103 as being unpatentable over Applicant's Admitted Prior Art in view of Richerson ("Modern Ceramic Engineering").

Applicant has admitted that known, modern cigarette-making machines comprise a conveyor which includes a duct defining an elongated path arranged to receive a continuous shower of tobacco particles (corresponding to the claimed "flowable particulate material"), said particles being converted into an elongated stream by a stretch of an endless foraminous belt to which the particles are attracted to the underside. The underside of said belt constitutes one wall of the duct, and the duct includes stationary additional walls (corresponding to the claimed "back support") serving to flank the sides of the path beneath the lower reach of the belt and being in continuous contact (corresponding to the claimed "direct contact") with the moving

tobacco particles. Applicant then states that attempts to ensure that the stationary walls of the duct will offer low resistance to sliding movement have included adding a coating of such walls with a steel paneling (corresponding to the claimed "lining") which is coated with tungsten carbide/cobalt, which also provides adequate resistance to wear. While Applicant's Admitted art may not state that the walls are coated with a ceramic material, Richerson states that the market for wear resistance is dominated by cermets, such as cobalt-bonded tungsten carbide. However, ceramics have been targeted as a means of reducing wear and friction and avoiding the chemical and galvanic attach to which bonded tungsten carbide is vulnerable (page 359). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to substitute the tungsten carbide cobalt with a ceramic, to achieve all of the benefits disclosed in Richerson, and since they are known for their use as liners.

Regarding claim 6, Applicant's Admitted Art modified by Richerson may not specifically articulate that the lining has a thickness in the range of between .05-.5 mm; however, it would have been obvious to one having ordinary skill in the art at the time of the invention to arrive at the claimed thickness ranges for the ceramic lining of the side-guides in an effort to optimize the efficiency of wear-resistance while minimizing material costs.

Regarding claim 18, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize an adhesive of some sort to secure the lining to the back support, since glue/paste is a well-known means by which to adhere items together.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Richerson ("Modern Ceramic Engineering"), and further in view of GB 885,485.

While Applicant's Admitted Prior Art modified by Richerson may not state that the surface adjacent the path has a consistency resembling that of the surface of an orange peel, GB 885,485 states that machine parts, made of metal, are often sprayed with ceramic material, in order to impart hardness and wear resistance, resulting in an abrasive surface (see page 1). This would suggest to one having ordinary skill in the art that the surface of the ceramic material would not be smooth and may have some irregularities/roughness (corresponding to the claimed "orange peel surface") that, based on the parameters of the operating system, could be adjusted or finished to ensure efficient wear resistance.

4. Claims 7, 9-11, 13-14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 197 33 443 in view of Applicant's Admitted Prior Art and Richerson ("Modern Ceramic Engineering").

DE 197 33 443 discloses a guide 1 (corresponding to the claimed "conveyor") for advancing a stream of tobacco particles (corresponding to the claimed "flowable particulate material"), comprising channel 7 (corresponding to the claimed "duct") defining a path for the tobacco particles and having sidewalls 14,16 (corresponding to the claimed "back support") flanking the channel, along with the lower stretch of foraminous belt 6 and inserts 4 which have marginal portions (corresponding to the

claimed "two additional walls") (see figs; Note: U.S. equivalent 6,186,315). While DE 197 33 443 may not articulate that at least one of said walls consists at least in part of a ceramic material, Applicant has admitted that it is known to coat these walls with a steel paneling which is coated with tungsten carbide/cobalt – which provides adequate resistance to wear. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to do so for this purpose. Further, while DE 197 33 443 modified by Applicant's Admitted Art may not state that the walls are coated with a ceramic material, Richerson states that the market for wear resistance is dominated by cermets, such as cobalt-bonded tungsten carbide. However, ceramics have been targeted as a means of reducing wear and friction and avoiding the chemical and galvanic attack to which bonded tungsten carbide is vulnerable (page 359). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the apparatus of DE 197 33 443 modified by Applicant's Admitted Art to include a ceramic coating on the walls in order to offer low resistance to the sliding movement of the tobacco particles that flow by said walls.

Regarding claim 7, while there may be no clear articulation as to whether the ceramic lining of DE 197 33 443 modified by Applicant's Admitted Prior Art is applied during its molten state or by spraying, this limitation is not deemed to impart any patentable weight to the claims since it articulates a *method* limitation (i.e. the manner in which ceramic is applied), not a *structural* limitation, when the claims are drawn to an apparatus. Apparatus claims must be *structurally* distinguishable from the prior art. See MPEP 2114.

Regarding claim 18, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize an adhesive of some sort to secure the lining to the back support, since this is a well-known means by which to adhere items together.

***Allowable Subject Matter***

5. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claim 16 is allowed.

***Response to Arguments***

7. Applicant's arguments filed on March 23<sup>rd</sup>, 2003 have been fully considered but are moot because of new grounds for rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



Dionne A. Walls

July 16, 2003